

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number: 25781-0007001 / 2002P00240US
<p>I hereby certify that this correspondence is being filed with the United States Patent and Trademark Office via the Electronic Filing System (EFS) on the date shown below.</p> <p><u>November 23, 2009</u> Date of Deposit</p> <p><u>/Dee Bacon/</u> Signature</p> <p><u>Dee Bacon</u> Typed or Printed Name of Person Signing Certificate</p>	Application Number 10/675,930	Filed September 29, 2003
	First Named Inventor Josef Dietl	
	Art Unit 2439	Examiner Farid Homayounmehr
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a Notice of Appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <div style="display: flex; justify-content: space-between; align-items: flex-start;"> <div style="width: 45%;"> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record <u>64,869</u> (Reg. No.)</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p> </div> <div style="width: 45%; text-align: right;"> <p>_____ Signature</p> <p><u>Jonathan A. Solomon</u> Typed or printed name</p> <p><u>(214) 747-5070</u> Telephone number</p> <p><u>November 23, 2009</u> Date</p> </div> </div> <p style="font-size: small; margin-top: 20px;">NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below'.</p>		
<input type="checkbox"/> Total of xx forms are submitted.		

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant :	Josef Dietl	Art Unit :	2439
Serial No. :	10/675,930	Examiner :	Farid Homayounmehr
Filed :	September 29, 2003	Conf. No. :	2375
Title :	HYBRID DIGITAL SIGNATURE WORKFLOW		

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REMARKS ACCOMPANYING PRE-APPEAL REQUEST FOR REVIEW

This Pre-Appeal Brief is responsive to the final Office Action mailed August 24, 2009 and the Advisory Action mailed October 22, 2009, in which all pending Claims 3–6, 13–16, and 18–28 were rejected. A Notice of Appeal accompanies this submission.

I. The Claims Fall Within a Statutory Class of Patentable Subject Matter

Claims 23–28 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Appellant respectfully traverses this rejection, as each of the pending claims falls within one of the statutory classes of patentable subject matter and because the claims satisfy at least one of the two tests articulated in the M.P.E.P.¹ For example, Claim 23 recites a computer program product, tangibly embodied in a machine-readable storage device, comprising instructions operable to cause a programmable processor to, *inter alia*, “convert the text content of the human-readable appearance of the print out to the canonical form of the text content,” transforming the text content of the print out to the canonical form of the text content. Claim 27 recites a computer program product, tangibly embodied in a machine-readable storage device, comprising instructions operable to cause a programmable processor to, *inter alia*, “create a print out of the electronic document to be sent to the external entity.” The claims clearly recite

¹ M.P.E.P. § 2106(IV)(C)(2) (“A claimed invention is directed to a practical application of a 35 U.S.C. 101 judicial exception when it: (A) “transforms” an article or physical object to a different state or thing; or (B) otherwise produces a useful, concrete and tangible result . . .”).

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elements that place the claims within one of the statutory classes of patentable subject matter pursuant to 35 U.S.C. § 101. As such, Appellant respectfully traverses the rejection and requests reconsideration and allowance of the claims.

II. The Claims Are Patentable Over Any Combination of *Slater*, *Shioda*, and *Nord*

Claims 3–6, 13–16, and 18–28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0069179 to Slater *et al.* (“*Slater*”) in view of U.S. Patent No. 6,634,559 to Shioda (“*Shioda*”) and further in view of U.S. Patent Application Publication No. 2004/0193543 to Nord *et al.* (“*Nord*”). Appellant respectfully traverses the rejection and assertions and holdings therein, because the above cited art, whether individually or in combination, fails to teach, suggest, or disclose certain aspects of the present claims², including example Claim 18.

As admitted by the Office Action, the following elements are “not explicitly taught by the combination of Slater and Shioda”:

- “receiving a modified print out at the workflow system back from the external entity, the modified print out comprising the print out sent to the external entity with a modification;”
- “validating the modified print out within the workflow system using the one or more control codes;”
- “integrating the validated and modified print out into the workflow; and”
- “continuing the workflow for the validated print out within the workflow system.”

Office Action, Aug. 24, 2009, at 8. *Nord* is thus apparently relied upon by the Office Action for teaching these elements. Appellant respectfully disagrees.

² Appellant reiterates the arguments made in previous responses that the *Slater-Shioda* combination fails to teach the elements of the claims. For example, the *Slater-Shioda* combination fails to teach “one or more second control codes generated from the canonical form of the text content [that] authenticate the text content” as recited in example Claim 18. *Nord* also fails to teach this example element of Claim 18. As such, the combination of the referenced art is deficient, and Appellant respectfully requests reconsideration and allowance of the claims.

A. Nord Fails to Overcome the Deficiencies of Slater and Shioda

Nord fails to teach certain elements of example Claim 18. Put simply, *Nord* is directed to generating a digital copy of a legally valid document by simultaneously signing the printed and electronic copies of the document. *See, e.g., Nord*, Abstract. Specifically, *Nord* teaches “a method for a simultaneous, legally binding, signing of a paper- and a digital document being provided with a single unique identity, wherein only one signing provides a legally valid paper original of [,]e.g.[,] an agreement, contract or the like having a digital equivalence.” *Nord* ¶ [0010]. For example, *Nord* teaches that the “simultaneous signing of the corresponding filled-in paper- and digital original documents can . . . be accomplished through placing the paper original 50 on top and fitting the outlining of the corresponding underlying digital original 30 being displayed on a digitizing means 60, connected to the computer device 10.” *Nord* ¶ [0067]. *Nord* then uses a unique identity appearing on both the digital and paper documents to verify that the unsigned documents are the same. *See Nord* ¶ [0067] (teaching that the “two originals 30, 50 to be simultaneously signed have the same unique code and that they thus constitute the same document” (emphasis added)). Further, “[a]n optical guide . . . can be provided for reading and, through the computerized device 10, enabling comparing, matching, the unique identification codes provided on the paper original 50 and on the respective underlying digital counterpart 30.”³ *Nord* ¶ [0067]. “The digitally signed original can then e.g. be sent with telecom. speed” to other parties. *Nord* ¶ [0069].

1. Nord Fails to Teach the “Validating” Element of the Present Claims

As can be seen from the description above, *Nord* does not teach “validating the modified print out within the workflow system using the one or more control codes,” as recited in the claims. First, *Nord* explicitly states that the only step resembling validation of the document occurs prior to the simultaneous signing of the document. *See Nord* ¶ [0067]. In other words,

³ *Nord* goes on to teach that the “optical guide can furthermore scan, read, that the overlying paper original is positioned correctly on the digitizing means, i.e., fitting the outlining of the thereupon displayed digital original, thus ensuring the signature’s identical positioning on both originals within a predetermined threshold value.” *Nord* ¶ [0067]. This indicates that the paper original is physically placed on top of the optical guide for the comparison of the unsigned originals.

Nord does not teach validating the document using control codes after it has been signed. Instead, *Nord* teaches that the identification appearing on the digital document is optically compared with the identification appearing on the paper document. *See Nord* ¶ [0067]. If the two identifications match, the paper and electronic documents are assumed to be the same document, and the signor is free to simultaneously sign the paper and digital originals by overlaying the paper document on the described digitizing means. Second, the present claims recite validating a document that has been modified by comparing control codes appearing on the modified document with control codes appearing on the unmodified, or original, document. In other words, the present claims recite comparing and validating two separate versions of a document: one modified and one unmodified, whereas *Nord* teaches comparing a digital and paper copy of the same (that is, unmodified) document. Third, since the original electronic and paper copies are signed at the same time, there would be no reason for *Nord* to use one or more control codes to validate the document after it has been modified. In other words, the simultaneous signing of the digital and electronic copies obviates the need to validate the signed document since the printed document is already determined to be identical to the digital document. This is further evidenced by the teaching of *Nord* that the unsigned documents are verified prior to the simultaneous signing. Therefore, *Nord* fails to teach at least this element of Claim 18, and thus fails to overcome the admitted deficiencies of the *Slater-Shioda* combination.

2. *Nord* Fails to Teach the “Integrating” Element of the Present Claims

Further, *Nord* fails to teach “integrating the validated and modified print out into the workflow,” as recited in example Claim 18. To the contrary, *Nord* teaches that simultaneously signing a paper and electronic copy of the document allows the electronic copy to be maintained in the workflow without having to scan, copy, or otherwise integrate the modified paper document back into the workflow. Moreover, *Nord* explicitly teaches away from scanning documents following a modification. For example, *Nord* states that the “processes of subsequent copying and scanning of signed contracts, agreements, deeds and the like documents” is “impractical, time-consuming, tedious and unnecessarily costly due to the manual effort

incorporated” and “demands extra equipment to be at hand in the form of e.g. bulky scanning and copying machines, a fact which ads [sic] to the inflexibility of the process as a whole.” *Nord* ¶ [0006]. Therefore, *Nord* not only fails to teach this element of Claim 18, but actually teaches away from integrating the validated and modified print out back into the workflow as recited in example Claim 18. Thus, *Nord* again fails to overcome the admitted deficiencies of the *Slater-Shioda* combination.

CONCLUSION

For at least the reasons advanced above, Appellants respectfully submit that the present claims are allowable over the cited prior art references. Reversal of the rejections under 35 U.S.C. § 103(a) is respectfully requested. If questions remain regarding the above, please contact the undersigned.

The fee for a Notice of Appeal in the amount of \$540 is being paid concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account authorization to Deposit Account No. 06-1050. Please apply any other charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: November 23, 2009

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